

Paper No. 18  
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U.S. DEPARTMENT OF COMMERCE  
PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re Time Warner Entertainment Company, L.P.

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Serial No. 75/100,922

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Francie R. Gorowitz of Ladas & Parry for Time Warner  
Entertainment Company, L.P.

John S. Yard, Trademark Examining Attorney, Law Office 104  
(Sidney Moskowitz, Managing Attorney).

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Before Simms, Hanak and Holtzman, Administrative Trademark  
Judges.

Opinion by Holtzman, Administrative Trademark Judge:

An application has been filed by Time Warner Entertainment  
Company, L.P. to register WARNER BROS. for restaurant services.<sup>1</sup>  
The application is based on an assertion of a bona fide intention  
to use the mark in commerce under Section 1(b) of the Trademark  
Act.

The Trademark Examining Attorney refused registration under Section 2(e)(4) of the Trademark Act on the ground that WARNER BROS. is primarily merely a surname and finding applicant's showing under Section 2(f) of the Act to be insufficient. When the refusal was made final, applicant appealed. Applicant and the Examining Attorney submitted briefs but an oral hearing was not requested.

The issues presented on this appeal are whether WARNER BROS. is primarily merely a surname under Section 2(e)(4) of the Trademark Act and if so, whether the fame of WARNER BROS. is sufficient to transfer the previously acquired distinctiveness of the mark to the proposed restaurant services.

***I. Whether WARNER BROS. is primarily merely a surname.***

In support of his contention, the Examining Attorney attached evidence from Phonedisc U.S.A. (1995 edition) and, at the time of appeal, an excerpt from the *Random House Unabridged Dictionary* (2<sup>nd</sup> ed. 1993) showing no entry for the word "Warner."<sup>2</sup>

Applicant initially maintained that WARNER BROS. is not primarily merely a surname arguing that (1) the primary significance of WARNER BROS. is the WARNER BROS. movie studios in view of the "the well-know[n] status and high visibility" of the mark in connection with movie studios and the goods and services

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<sup>1</sup> Application Serial No. 75/100,922; filed May 2, 1998.

<sup>2</sup> The Board may take judicial notice of dictionary entries.

offered in connection therewith and that (2) the term BROS. is arbitrary with respect to restaurant services.

However, in its reply brief, applicant no longer appears to dispute the contention that WARNER BROS. is primarily merely a surname.<sup>3</sup> Nevertheless, to the extent that applicant maintains its position that WARNER BROS. is not a surname, the argument is rejected. The record clearly establishes the surname significance of the term. The search from the Phonedisc U.S.A. database<sup>4</sup> yielded listings for more than 29,000 individuals having the surname "Warner" and by the dictionary reference, the Examining Attorney has established "Warner" has no non-surname significance. Despite applicant's contention, the addition of BROS. to WARNER serves to reinforce rather than diminish the surname significance of WARNER and the fact that the term would be perceived as a surname. See, for example, *In re Etablissements Darty et Fils*, 759 F.2d 15, 225 USPQ 652, 653 (Fed. Cir. 1985) ["(Darty et Fils translates as Darty and

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<sup>3</sup> In particular, applicant states therein that it has "submitted evidence of acquired distinctiveness and seeks registration pursuant to §2(f) of the Trademark Act..." and "[a]ccordingly, the Examining Attorney's contention that 'the mark WARNER BROS. is primarily merely a surname such that a refusal to register the mark under Section 2(e)(4)[is proper]' is moot."

<sup>4</sup> The preface to the Phonedisc U.S.A. printout indicates that the database includes a total of 83,000,000 listings.

Son)....This, in itself, is highly persuasive that the public would perceive DARTY as a surname."].

Further, applicant has failed to rebut the prima facie case established by the Examining Attorney with any evidence that the term would not be perceived as a surname. We would also point out, notwithstanding any asserted fame of WARNER BROS., that the term has no "primary" meaning other than that of a surname. The trademark significance of the term is due to the distinctiveness that has been acquired over the years. See *In re McDonald's Corp.*, 230 USPQ 304 (TTAB 1986). Although WARNER BROS. may be the surname of a famous company, it is still primarily a surname.

***II. Whether the fame of WARNER BROS. is sufficient to transfer the previously acquired distinctiveness of the same mark for other services to the proposed restaurant services.***

Applicant argues that the WARNER BROS. mark is famous, that the mark has acquired distinctiveness based on applicant's ownership of prior registrations "for the same mark for related goods and services," and that this previously acquired distinctiveness transfers to the restaurant services herein. Applicant contends that its operation of restaurants within its studio store "further [connects] the WARNER BROS. name with restaurant services."

In support of its position, applicant submitted copies of its seven prior registrations. Applicant also submitted two declarations by Nils Victor Montan, Assistant Secretary of one of

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applicant's general partners, accompanied by what appear to be photocopies and photographs of containers for a variety of cereals and snack food products showing licensed use of Warner Bros.' marks. Finally, applicant attached a cover page from a search from the NEXIS database showing 3,000 references for WARNER BROS. since March 21, 1997.

Applicant has claimed ownership of the following registrations:

**Registration No. 391,866** for "motion pictures and motion picture films, which have records of sound, words, and/or music thereon, and motion picture films adapted for synchronization with sound, words, and/or music records; synchronized apparatus for simultaneously reproducing coordinated light and sound effects and the component parts of such apparatus."<sup>5</sup> (Class 9).



**Registration No. 680,457** for "phonograph records and tapes with sound recorded thereon."<sup>6</sup> (Class 9).



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<sup>5</sup> Issued November 25, 1941; alleging a date of first use of September 1939; second renewal; no disclaimer.

<sup>6</sup> Issued June 16, 1959; renewed; alleging a date of first use of August 28, 1958.

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**Registration No. 1,026,466** for "providing film and tape entertainment for viewing through the media of television and cinema."<sup>7</sup> (Class 41).

**WARNER BROS**

**Registration No. 1,912,001** for "retail store for clothing toys, stationery, posters, housewares, artwork, jewelry and other gift items."<sup>8</sup> (Class 42).

**WARNER BROS. STUDIO STORE**

**Registration No. 1,978,089** for "prerecorded records and prerecorded audio and audio-video tapes, cassettes and discs featuring a compendium of sound effects and/or accompanying visual images."<sup>9</sup> (Class 9).

**WARNER BROS. SOUND EFFECTS LIBRARY**

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<sup>7</sup> Issued December 2, 1975; alleging a date of first use of September 13, 1971; renewed. We note that no period follows BROS in the registration. However, for the sake of simplicity, we will include a period when referring to the registered mark in the remainder of this decision.

<sup>8</sup> Issued August 15, 1995; alleging a date of first use of September 1991; STUDIO STORE has been disclaimed.

<sup>9</sup> Issued June 4, 1996; alleging a date of first use of April, 1993; SOUND EFFECTS LIBRARY has been disclaimed.

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**Registration No. 1,969,829** for "motion picture and television films featuring action, adventure, animation, comedy, drama, or music; prerecorded goods, namely prerecorded records and prerecorded audio and audio-video tapes, cassettes and discs featuring action, adventure, animation, comedy, drama, or music; film clips featuring action, adventure, animation, comedy, drama, or music within cassettes used with hand-held viewers or projectors; audio, video, audio and video tape, cassette, disc playback and recorders."<sup>10</sup> (Class 9).



**Registration No. 2,017,816** for "television production, television program syndication, production of television programs, production of cable television programs, production of closed caption television programs, distribution of television programs for others, entertainment in the nature of ongoing news, comedy, live action, animated and/or variety television programs."<sup>11</sup> (Class 41).



Mr. Montan, in his first declaration, states that WARNER BROS. has been used since "the early 1900's" to identify movies

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<sup>10</sup> Registration No. 1,969,829; issued April 23, 1996; claiming a date of first use of April 1993.

<sup>11</sup> Registration No. 2,017,816; issued November 19, 1996; alleging a date of first use of September 3, 1955. TELEVISION has been disclaimed.

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and that WARNER BROS. in fact identifies over 3,000 movies. Mr. Montan further states that for over 14 years WARNER BROS. has been one of top three film studios in box office sales and is a "prolific" producer of prime time network programming. Further noting that WARNER BROS. operates the Warner Bros. Museum as a part of the Warner Bros. Studio Tour in Burbank, California, Mr. Montan points out that WARNER BROS. also operates theater complexes throughout the world using the WARNER BROS. mark and that WARNER BROS. is also the name of one of the major record labels of Warner Bros. Records. According to Mr. Montan, WARNER BROS. has been involved in numerous food-related promotions, and WARNER BROS. sells various food items worldwide under its LOONEY TUNES marks. Mr. Montan states that WARNER BROS. is also involved in the retail sale of clothing, movie memorabilia, souvenirs and a variety of other merchandise at its WARNER BROS. STUDIO STORE. The first such store opened in September 1992, according to Mr. Montan, and there are now over 150 stores throughout the world. Mr. Montan states that revenues for the entertainment division, which includes the studio stores (but not the music division) for the years 1993-1996 have approximated \$19.7 billion.

In his second declaration, Mr. Montan states that Warner Bros. has been operating restaurants "in some" of its WARNER BROS. STUDIO STORES for at least 2 years. Mr. Montan describes

the restaurant operated in applicant's New York store as having changing themes based upon popular Warner Bros.' movies and television shows.

The Examining Attorney, while not disputing the fame of WARNER BROS. for "a broad range of entertainment related goods and services," contends that applicant has failed to establish acquired distinctiveness under Section 2(f) based on (1) ownership of a prior registration for the same mark for related goods or services, or (2) either a prima facie showing or other direct evidence of use of the same mark on related goods or services. The Examining Attorney maintains that the two-year existence of the restaurant in applicant's WARNER BROS. STUDIO STORE is insufficient to establish acquired distinctiveness of WARNER BROS. in connection with restaurant services.

**A. *The fame of the WARNER BROS. mark.***

Based on the evidence of record, we conclude that WARNER BROS. is an enormously famous mark in the entertainment industry. The evidence shows that applicant has used the WARNER BROS. mark in connection with a wide range of products and services related to the entertainment industry, including films and television shows, studio tours, film libraries and museums, movie theaters, television programming and syndication, retail stores, collateral merchandise, record production and food products. The mark has been in use for the better part of a century, and we have

evidence of nearly \$20 billion in revenues in connection with these many entertainment-related goods and services over a recent three-year period alone.

Although we agree with applicant that WARNER BROS. has achieved considerable fame in the entertainment field, the question still remains as to whether the same mark (WARNER BROS.) has acquired distinctiveness for services which are sufficiently related to applicant's other goods and services as to warrant registration under Section 2(f).

***B. Acquired distinctiveness of the same mark in connection with related services.***

A claim of distinctiveness under Section 2(f) is permitted in an application (whether or not based on use) if the applicant can establish, by appropriate evidence, that the same mark has acquired distinctiveness in connection with other goods or services which are sufficiently related to those in the application such that the acquired distinctiveness will carry over to the goods or services in the application (upon use, in the case of an intent-to-use application). See Trademark Rule 2.41; *In re Rogers*, 53 USPQ2d 1741 (TTAB 1999); and TMEP §§ 1212.04 and 1212.09(a).

This evidence can consist of, inter alia, ownership of a prior registration for the same mark for related goods or services or actual evidence of acquired distinctiveness for the

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same mark with respect to the other goods or services. See Trademark Rule 2.41(b) and *In re Loew's Theatres, Inc.*, 223 USPQ 513, 514 (TTAB 1984), *aff'd*, 769 F.2d 764, 226 USPQ 865 (Fed. Cir. 1985).

***i. Acquired distinctiveness of the same mark***

We find that applicant has established the previously acquired distinctiveness of the WARNER BROS. mark by its ownership of a registration (Registration No. 1,026,466) for that same mark. The mark is registered for services identified as "providing film and tape entertainment for viewing through the media of television and cinema" or, more concisely, movie studio services. We note that this WARNER BROS. mark was registered without resort to Section 2(f) or any apparent showing of acquired distinctiveness. Nevertheless, the registration is over 25 years old, and acquired distinctiveness is conclusively presumed for a mark with an incontestable registration. See J. Thomas McCarthy, *Trademarks and Unfair Competition*, § 11:82 (4th ed. 1999). In any event, we find the evidence submitted by applicant more than adequate to support a claim that the WARNER BROS. mark has acquired distinctiveness for movie studio services.

***ii. Relationship of the services***

Even in the case of a famous mark, an applicant needs to show "some degree of relationship" between the goods and/or

services for which the mark is famous and the goods and/or services in the application. See *In re Rogers*, supra.<sup>12</sup> The more famous a mark, the more likely it is to be associated in the public mind with a greater breadth of products or services.<sup>13</sup> Thus, the "degree" of relationship between the goods or services may vary depending upon the degree of fame achieved by the mark.

With the above standard in mind we believe that in view of the extensive fame of the WARNER BROS. mark, the movie studio services for which the mark is already used and registered are sufficiently related to the restaurant services for which registration is sought.

We begin by noting that in today's marketing environment, both movie studios and restaurant services fall under the broad category of entertainment services. Movie studios, of course, have always been synonymous with entertainment. Restaurants have, of late, expanded to include a variety of entertainment

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<sup>12</sup> The Board in that case rejected the statement in TMEP § 1212.09(a) which essentially states that if a mark is famous in connection with specified goods or services, we can presume that the mark will acquire distinctiveness in connection with unrelated goods or services upon use. See *In re Rogers*, supra, p. 1745.

<sup>13</sup> See, e.g., *Kenner Parker Toys Inc. v. Rose Art Industries Inc.*, 963 F.2d 350, 22 USPQ2d 1453 (Fed. Cir. 1992) and *R.J. Reynolds Tobacco Co. v. R. Seelig & Hille*, 201 USPQ 856 (TTAB 1978).

functions, for example, themed restaurants.<sup>14</sup> In fact, at least one court has noted the "proliferation" of these "successful and popular restaurants."<sup>15</sup> Another court has referred to such establishments (as, for example, Planet Hollywood, Hard Rock Cafe and Harley-Davidson Cafe) as part of the "eatertainment industry" made up of movie or music-themed restaurants that provide both food and an entertaining environment."<sup>16</sup> In particular, the court recognized that Planet Hollywood emphasizes its association with, as the name suggests, Hollywood, and presents memorabilia from Hollywood movies spanning a variety of genres and generations as well as clips of movies and the sale of movie merchandise.<sup>17</sup>

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<sup>14</sup> Contrary to the position taken by the dissent, the Board has discretion to take judicial notice, regardless of whether we are requested to do so by either the applicant or the Examining Attorney. See Fed. R. Evid. 201(c). Further, the Board (as well as our primary reviewing court) has on many occasions exercised that discretion and taken judicial notice whether or not requested by any party. See, for example, *The B.V.D. Licensing Corp. v. Body Action Design Inc.*, 846 F.2d 727, 6 USPQ2d 1719 (Fed. Cir. 1988); *The Wella Corporation v. California Concept Corporation*, 194 USPQ 419 (CCPA 1977); *Continental Airlines Inc. v. United Air Lines Inc.*, 53 USPQ2d 1385 (TTAB 1999); and *In re London & Edinburgh Insurance Group Ltd.*, 36 USPQ2d 1367 (TTAB 1995). In any event, we have properly taken judicial notice of reasonably indisputable facts as permitted by Rule 201(b).

<sup>15</sup> See *Elvis Presley Enterprises Inc. v. Capece* 950 F. Supp. 783 (S.D. Tex. 1996), rev'd, 141 F.3d 188, 46 USPQ2d 1737 (5th Cir. 1998).

<sup>16</sup> See *Planet Hollywood (Region IV), Inc., et al. v. Hollywood Casino Corporation, et al.*, 80 F. Supp. 2d 815 (N.D. Ill. 1999).

<sup>17</sup> *Planet Hollywood (Region IV), Inc. v. Hollywood Casino Corporation*, supra.

In short, there is natural connection between entertainment and the sale and consumption of food. In view of the extensive fame of the WARNER BROS. mark, there is a sufficient relationship between those activities so that today's consumers would automatically associate WARNER BROS. as used in connection with a restaurant with the very same WARNER BROS. company that makes movies.

Moreover, the fact that applicant is itself currently licensing its character marks and images to sell food products as well as operating its own restaurant under one of the WARNER BROS. marks further bolsters the position that restaurant services may be a logical extension of the services a movie studio might provide and that there is at least "some degree of relationship" between the two services.

We are mindful of the limitation, as set forth by the Board in *In re Rogers*, supra, as to the impact of fame on the relatedness of the goods or services. In justifying this limitation, the Board points to the context of a likelihood of confusion analysis in stating that the owner of a mark is not entitled to preclude the subsequent registration of the same or similar mark in connection with any and all goods and services including those completely unrelated to the trademark owner's goods stating that to do so, would be to bestow upon a trademark owner a right in gross.

At the same time, however, we note that by the Federal Trademark Dilution Act of 1995 (Section 43(c) of the Trademark Act) Congress recognized that "a mark...[may] have acquired its fame in connection with one type of good or service...[but can become] *so famous as to be entitled to protection against dilution when used on or in connection with an unrelated good or service.*" (Emphasis added). H. R. Rep. No. 374, 104<sup>th</sup> Cong., 1<sup>st</sup> Sess. 1995, 1995 WL 709280, pg. 3 (Leg. Hist.).

It is clear that WARNER BROS. is not a mark that is famous in a narrowly defined market familiar only to a small segment of the public. The fame of WARNER BROS. is national, if not international in scope. Moreover, while the services in this case are not identical, neither is applicant is attempting to establish that acquired distinctiveness has been transferred from services so disparate and remote as to even conceivably be considered a right in gross in its mark. Our decision simply reflects the commercial reality that the long use and extensive public exposure to the WARNER BROS. marks over a 75-year period in connection with a wide array of products and services leads to the inescapable conclusion that a customer of applicant's WARNER BROS. restaurant would, immediately upon its opening, attribute source-identifying significance to the WARNER BROS. mark.

The dissent has taken an overly rigid approach to the determination of the ultimate issue in this case, whether WARNER

BROS. would be perceived as indicating source for a restaurant service. While conceding that WARNER BROS. is famous, the dissent has essentially ignored the effect of fame on the issues in this case.<sup>18</sup> Even more baffling is the dissent's statement that he agrees with the majority's position that "people may well associate a new restaurant opening under the WARNER BROS. mark with applicant." Acquired distinctiveness is that very *association* in the consumer's mind between the mark and the source of the goods or services.<sup>19</sup> Having effectively conceded that the public would recognize WARNER BROS. as a mark for applicant's new restaurant services, it is remarkable that the dissent still believes that the mark is not registrable.

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<sup>18</sup> Moreover, the cases relied on by the dissent are not on point. Fame was not in issue in any of those cases. Obviously, the determination that a particular mark is strong or distinctive does not mean the mark is famous.

<sup>19</sup> See, for example, *In re Brass-Craft Manufacturing Co.*, 49 USPQ2d 1849 (TTAB 1998) citing *In re Semel*, 189 USPQ 285 (TTAB 1975). See also *Carter-Wallace, Inc. v. Procter & Gamble Co.*, 434 F.2d 794, 167 USPQ 713 (9<sup>th</sup> Cir. 1970) ["Secondary meaning has been defined as *association*, nothing more."].

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Decision: The refusal to register is reversed.

E. W. Hanak

T. E. Holtzman  
Administrative Trademark  
Judges, Trademark Trial  
and Appeal Board

Simms, Administrative Trademark Judge, concurring in part and dissenting in part:

I concur with the holding of the majority that WARNER BROS. is primarily merely a surname. However, I disagree with the holding that applicant has shown, as a result of ownership of prior registrations or other evidence, that the mark intended to be used for restaurant services has acquired distinctiveness.

In my view, the opinion of the majority goes far beyond what precedent allows. The question here is whether this applicant has demonstrated on this record that its mark WARNER BROS. has acquired distinctiveness for the restaurant services it intends to offer;<sup>20</sup> that is, whether this mark has become distinctive for restaurant services on the basis of a prior registration for the same mark for related services or on the basis of acquired distinctiveness of the same mark for related services. The majority glosses over deficiencies in the record and attempts to make up for them by taking judicial notice. Moreover, and aside

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<sup>20</sup> For the purpose of this opinion, I accept the proposition that a mark can "acquire distinctiveness" with respect to certain goods or services when it has never been used for those goods or services. I note that when the Trademark Law Revision Act first went into effect in 1989, there was no provision for the registration of a mark, under Section 2(f) of the Act, which was intended to be used, in the absence of an amendment or statement of use, apparently under the theory that a mark never used for certain goods or services could not be said to have become distinctive of (or have taken on a primary source-identifying significance for) those goods or services. However, the Office guidelines were modified to allow registration of even these marks under Section 2(f), under certain circumstances, without any evidence of use. See discussion of this matter in *In re Rogers*, 53 USPQ2d 1741, 1744 n.3 (TTAB 1999).

from the fact that this evidence does not establish the relationship needed in this case, we should not help "prove" an applicant's case for it by taking judicial notice when it has not requested us to do so. Indeed, except for applicant's first response to the initial refusal to register, the subject of entertainment-themed restaurants was never mentioned by applicant, and there is no mention of this matter in applicant's briefs on the case.

The fact that there may be some restaurants that are entertainment-themed does not show a sufficient relationship between *movie studios* or *movie production services* and restaurants, any more than the fact that there are sports-related bars and restaurants shows a relationship between ownership or sponsorship of, say, a baseball team (or, in the vernacular of this Office, "entertainment services in the nature of baseball games") and ownership of a restaurant. There is no evidence that any of these entertainment-themed restaurants also make or produce movies. Applicant might have been able to attempt to establish a relationship between movie studio services and restaurant services by such evidence as declarations attesting to the rendering by the same entity of movie studio services and restaurant services under the same mark, by third-party registrations of the same mark covering both services, or by other means. This it has not done. As the Board noted in the

Rogers case, any such evidence should have been supplied by the applicant.

Nor does applicant's use of a *different* mark (LOONEY TUNES, for example) for various snack food items help support registration of the mark WARNER BROS. for restaurant services, as the majority seems to contend.

The majority also says that both movie studio services and restaurant services fall under the category of "entertainment services." However, this Office (nor the general public for that matter) does not regard restaurant services as a type of "entertainment service." Restaurant services are in Class 42, while movie production or "movie studio" services are in Class 41. Even if a restaurant were to offer certain entertainment services under a mark, those services themselves would be in Class 41, not the restaurant service class. I do not believe, therefore, that both restaurant services and motion picture production services can be said to be "entertainment services"; only the latter is. The majority's further statement that consumers would expect one company to be both a movie producer and to offer restaurant services is simply not supported by anything in this record. It is certainly not supported by the mere fact that there are music- or movie-themed restaurants.

Nor is the concept of dilution, discussed by the majority, particularly helpful here. The fact that such a claim may be

made by a plaintiff to stop the lessening of the distinctiveness of a mark does not mean that there is a sufficient relationship under existing authority to show that the same mark used for movie studio services has "acquired distinctiveness" for restaurant services so as to lead to registrability under the doctrine of "transference" of acquired distinctiveness.

Trademark Rule 2.41(b) provides that an Examining Attorney may accept, as *prima facie* evidence of acquired distinctiveness, ownership by the applicant of one or more prior registrations of the same mark on the Principal Register or under the Act of 1905. See also Trademark Manual of Examining Procedure §1212.04.

A claim of acquired distinctiveness, by definition, requires use, and, therefore, a claim of distinctiveness is not typically filed in an intent-to-use application before an applicant files an amendment to allege use or a statement of use. See TMEP §1212.09(a). However, an intent-to-use applicant may file a claim of acquired distinctiveness under Section 2(f) before filing an amendment to allege use or statement of use provided that applicant can establish that, as the result of use of the same mark on other goods or services, the mark has become distinctive of those other goods or services and that this distinctiveness will "transfer" to goods or services listed in the application. TMEP §1212.09(a). Such a showing may consist of a claim of ownership of a prior registration for the same mark

for related goods or services, a *prima facie* showing of acquired distinctiveness based on five years' use of the same mark in connection with related goods or services, or actual evidence of acquired distinctiveness for the same mark with respect to the other goods or services. See TMEP §1212.09(a). However, the Manual notes:

The goods and services identified in the application must be sufficiently related to the goods and services specified in the claim to support a determination that the previously creative distinctiveness will transfer to the goods and services in the application upon use.

The Examining Attorney has some discretion in determining whether the mark sought to be registered is the "same" as that of the registration(s) or the previously used mark. Aside from the identity of the marks in the registration (or previously used) and the application, the Examining Attorney must determine whether the goods or services listed in the application are sufficiently similar to the goods or services listed in the prior registration. See TMEP §1212.04(c).

Here, it is clear that applicant owns no prior registration of the same mark for related services and that any use of a mark in connection with the same or similar services (for example, a restaurant within a retail store) is rendered under a different mark, and that mark has been in use for only two years.

Applicant's other registrations cover different marks and are for goods and services even more unrelated to restaurant services.

Applicant's registration covering the same mark (Registration No. 1,026,466) issued for "providing film and tape entertainment for viewing through the media of television and cinema."<sup>21</sup> While the mark is the same, the services listed in this registration are completely unrelated to restaurant services.

With respect to applicant's registration covering the mark WARNER BROS. STUDIO STORE, that registration obviously issued for a somewhat different mark and covered "retail store services in the nature of clothing, toys, stationery, posters, housewares, art work, jewelry and other gift items." Not only does that registration cover a different mark (and applicant has

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<sup>21</sup> The majority interprets this to be "movie studio services." It is not at all clear to me that the services listed in this registration, asserted in the registration to have been offered under the mark only since 1971, are the same as movie studio services, that is, the actual production of movies, offered by applicant since long before then. The providing of film and tape entertainment would only appear to be "movie studio services" if the word "producing" were substituted for "providing." A distributor (and not a producer) may also "provide" film and tape for television and the cinema. I note that applicant has another service mark registration (Reg. No. 2,017,816) specifically listing production services, and it is not understood why "providing" should be interpreted as other than "supplying," one of this word's dictionary definitions. However interpreted, the "providing" of film and tape entertainment and movie studio services are completely unrelated to restaurant services. For the purpose of this opinion, however, I will accept the majority's terminology and interpretation.

Suffice it to say that, aside from this registration, the Montan declarations serve the purpose of demonstrating acquired distinctiveness (and indeed fame) of the mark WARNER BROS. for movie and television production services.

not argued to the contrary), but also those retail stores services are also unrelated to restaurant services.

Applicant has submitted a declaration of an officer of a general partner, indicating that applicant operates a restaurant in some of those STUDIO STORE stores and has been doing so for at least two years. However, as noted, not only is that mark specifically different from the mark herein sought to be registered, but also there is no adequate evidence to support acquired distinctiveness as the result of the use of that mark in connection with those restaurant services offered within a retail store.

The Examining Attorney has cited *In re McDonald's Corporation*, 230 USPQ 304, 307 (TTAB 1986), where the Board stated (concerning a claim that MCDONALD'S was not primarily merely a surname but rather an inherently distinctive indication of origin):

We further note that even assuming, *arguendo*, that we accepted applicant's position that the evidence of record was sufficient to show that "MCDONALD'S" was not primarily merely a surname and registrable without a Section 2(f) claim, we would nevertheless refuse registration under Section 2(e)(3) as to the 397,665 application for clothing items since the relied-upon evidence of record relates to applicant's primary business of restaurants and food items obtained in such restaurants.

In that case, we specifically noted that any use of a surname in connection with restaurant services did not support registration

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of the same mark in connection with clothing items, because those goods were not sufficiently related. I believe that case is authority supporting the refusal herein.

As noted, the majority's decision in this case is contrary to precedent, both of this Board and the Court of Appeals for the Federal Circuit. This precedent requires an applicant to establish (and not by "mere conjecture") acquired distinctiveness of the same mark in connection with other sufficiently related goods or services in connection with which the mark is in use in commerce so that the previously created distinctiveness will transfer to the goods or services in the application upon use. See *In re Rogers*, *supra*, and authority cited therein. I am unable to find any authority for the application of the doctrine of transference of secondary meaning (acquired distinctiveness) to the extent the majority has done here, where such diverse services as movie studio services and restaurant services were involved. See *McFly Inc. v. Universal City Studios, Inc.*, 228 USPQ 153, 159 (C.D. Cal. 1985)(in denying injunction against use of "McFly" for motion picture characters on basis of same mark for bar and restaurant services, court stated, "As a matter of law, on these facts, motion pictures are unrelated to bar and restaurant services and defendant's use is unrelated to plaintiff's use.")

In *Bausch & Lomb Inc. v. Leupold & Stevens Inc.*, 6 USPQ2d 1475 (TTAB 1988), applicant had filed an application to register a "gold ring" design in connection with telescopic sights, rifle scopes, handgun scopes, binoculars and spotting scopes. The opposer conceded that, by virtue of the evidence of record and applicant's prior registration for essentially the same mark for rifle scopes, the gold ring design had acquired distinctiveness in connection with rifle scopes and handgun scopes. But opposer contended that the gold ring design had not acquired distinctiveness for the binoculars and spotting scopes. Applicant conceded that the gold ring design was not inherently distinctive and that applicant's limited use of the design in connection with binoculars and spotting scopes was insufficient to establish acquired distinctiveness for these goods. However, applicant asked the Board to find that, because the gold ring design had become distinctive of applicant's rifle scopes and handgun scopes, this goodwill and reputation transferred to applicant's new products which were sold to the same customers as applicant's rifle scopes and handgun scopes. Citing *Levi Strauss & Co. v. Genesco, Inc.*, 742 F.2d 1401, 222 USPQ 939, 942 (Fed. Cir. 1984), and *In re Loew's Theatres, Inc.*, 769 F.2d 764, 226 USPQ 865, 869 (Fed. Cir. 1985), the Board concluded that "[w]hile applicant can rely to some degree on the distinctiveness which its gold ring device has achieved vis-à-vis rifle scopes and

handgun scopes to help demonstrate that the gold ring device has become distinctive of applicant's related products (i.e., binoculars and spotting scopes), applicant must nevertheless present some direct evidence showing that its gold ring device has become distinctive vis-à-vis binoculars and spotting scopes." The Board held that "[a]pplicant has simply failed to carry [the] burden [of establishing that the gold ring device has become distinctive of applicant's binoculars and spotting scopes] in that it has presented no evidence demonstrating that the public recognizes gold ring devices appearing on binoculars or spotting scopes as indicating that these goods originate with, are sponsored by or otherwise associated with applicant." We stated, at 1478:

Applicant's almost total reliance on the distinctiveness which its gold ring device has achieved vis-à-vis rifle scopes and handgun scopes is simply not sufficient by itself to establish that the same gold ring device has become distinctive vis-à-vis binoculars and spotting scopes.

In the case of *Levi Strauss & Co. v. Genesco, Inc.*, supra, Levi Strauss argued that its tab design could be presumed to be distinctive for shoes based on Levi Strauss' registration and use of the tab for pants and jeans. The Court, in affirming the Board's grant of summary judgment to Genesco, stated that "[t]he strength of the tab as a trademark for pants might be relevant if there were evidence establishing public awareness and

transference of its trademark function to related goods ... and Levi's mere assertion of the possibility of such transference does not raise a genuine issue of material fact."

In refusing to find that the geographically descriptive term DURANGO had become distinctive for chewing tobacco based solely on applicant's prior registration of DURANGO for cigars, the Court in *In re Loew's Theatres, Inc.*, supra, stated that "the issue of acquired distinctiveness is a question of fact," and "[n]othing in the statute provides a right ipso facto to register a mark for additional goods when items are added to a company's line or substituted for other goods covered by a registration." Indeed, in the Board's decision, we noted, at 514:

Appropriateness in this kind of case generally means that the existing registration was acquired based on a finding that the term sought to be registered had become the distinctive of the goods and services, which finding could be carried over to the closely related goods or services in respect of which the new application was filed [citations omitted]. Even then, the existence of a registration for related goods is not necessarily sufficient in all cases to justify the grant of a new registration.

See also, *G.H. Mumm & Cie v. Desnoes & Geddes Ltd.*, 917 F.2d 1292, 16 USPQ2d 1635, 1639 (Fed. Cir. 1990) ("We agree with the Board that Appellant Mumm's mark is a strong mark for sparkling wines. We do not extend that view to other products such as beer

- Mumm has neither marketed a beer nor registered its mark for beer.")

Where "transference" was permitted to support a new registration, the goods or services were closely related. For example, In re Lytle Engineering & Mfg. Co., 125 USPQ 308 (TTAB 1960), the Board held that ownership of a prior registration of LYTLE for such services as the planning, preparation and *production of technical publications* was sufficient *prima facie* evidence of distinctiveness of the identical mark for brochures, catalogs and bulletins.

Accordingly, while established distinctiveness of a mark in use in commerce in connection with certain goods or services may transfer to an applicant's intended use of that mark in connection with goods or services identified in an intent-to-use application, an applicant must establish, by appropriate evidence, the extent to which the goods or services in the intent-to-use application are related to the goods or services in connection with which the mark is distinctive, and that there is a strong likelihood that the mark's established trademark function will transfer to the related goods or services when use in commerce occurs. See In re Rogers, *supra* at 1745. As we stated therein:

Simply because the mark may not have been used on or in connection with the goods or services identified in the intent-to-use application, applicant

is not excused from the need to demonstrate this strong likelihood of transference in order to establish acquired distinctiveness of the mark in connection with the goods or services with which applicant intends to use the mark.

We noted in that case that, in an intent-to-use case, an applicant could introduce evidence regarding practices in the relevant industry in order to show relatedness. This applicant has not done in this case. Moreover, applicant must do so by a preponderance of the evidence. See *Yamaha International Corp. v. Hoshino Gakki Co.*, 840 F.2d 1572, 6 USPQ2d 1001 (Fed. Cir. 1988).

Finally, as the majority has noted, the Board has recently criticized the provision of the Manual that indicated that, if a mark were famous, the goods or services in connection with which it was used need not be related to the goods or services set forth in the subject application. See *Rogers*, *supra* at 1745. The Board stated that the owner of a famous mark must still establish a strong likelihood of transference of the trademark function to the goods or services identified in the intent-to-use application. Accordingly, the mere fame of applicant's mark, which is not in doubt, is insufficient in this case as well.

Here, I believe the Examining Attorney has followed case law and the Manual's guidelines. If the Court and the Board have not found a sufficient relationship between gun scopes and spotting scopes, between jeans and shoes, between cigars and chewing tobacco, and between wine and beer, I do not believe the majority

is on solid grounds in finding, especially on this record, a sufficient relationship between applicant's "movie studio services" and its restaurant services. The Examining Attorney did not abuse his discretion in finding that applicant has failed to demonstrate transference of any acquired distinctiveness and we should not reverse based on applicant's inadequate showing of relatedness.

Accordingly, I agree with Examining Attorney that applicant's prior registrations issued either for different marks and for unrelated goods or services or, when for the same mark, for also unrelated services. The record lacks a *prima facie* showing of acquired distinctiveness of the same mark for related goods or services. While I have no doubt that applicant could, once sufficient use has commenced, demonstrate acquired distinctiveness of its mark in connection with restaurant services by the usual means frequently used for demonstrating such distinctiveness, I do not believe we are at liberty to break with precedent and allow registration of a surname in the absence of at least a showing of acquired distinctiveness in connection with related goods or services.

To be clear on one point: I agree with the majority that people may well associate a new restaurant opening under the WARNER BROS. mark with applicant. However, what we are talking about here is the registration of a surname under the provisions

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of Section 2(f), which requires the acquisition of secondary meaning. Our precedent requires that, in order for this to be permitted, the goods or services for which applicant now seeks registration and those in connection with which it has previously used its distinctive (or famous) mark must be related. I simply see no relationship between the producing of movies and television programs and the operation of a restaurant.

R. L. Simms  
Administrative Trademark  
Judge, Trademark Trial  
and Appeal Board